IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Appln. of :	)	
	)	
HARVEY et al.	)	Group Art Unit: 2731
	)	
Serial No.: 08/470,571	)	Examiner: William Luther
	)	
Filed: June, 6 1995	)	

For: SIGNAL PROCESSING APPARATUS AND METHODS

PETITION TO THE COMMISSIONER UNDER 37 C.F.R. § 1.181

Assistant Commissioner for Patents
BOX DAC
Washington, DC 20231

Sir:

This petition is a request that the Commissioner of Patents and Trademarks ("Commissioner") exercise his supervisory authority in two separate circumstances: (1) over the Examiner responsible for this application with respect to an Office Action mailed January 7, 2000, in the above-referenced patent application and (2) over the Group Director who is responsible for supervision of the Examiner assigned to the present application and who is additionally responsible for the other examiners in Technology Center 2700 assigned to examine other applications related to the present application because they share a parent disclosure under 35 U.S.C. § 120.

1. Applicants respectfully petition the Commissioner to impose a schedule on the examiners responsible for this and related applications, including the Group Director, who has overall supervisory authority over the examiners and supervisory examiners responsible for all these applications. Applicants urge that the Commissioner require the examiners responsible for each active application to issue an Office Action within thirty days of the Commissioner's grant of this petition and to respond to each subsequent amendment or Rule 111 response within thirty days after its filing with the Patent and Trademark Office (PTO). Such a schedule would impose a time limit prohibiting further delay in issuing Office Actions and other correspondence in this application and the other applications related under 35 U.S.C. § 120.

2. Applicants respectfully petition the Commissioner to require the Examiner to withdraw a so-called "Administrative Requirement" imposed on Applicants by the Examiner in the Office Action enumerated above.

The Administrative Requirement, its improper nature, and the unreasonable delays of the PTO requiring a Commissioner mandated schedule are described in detail below. A $130.00 fee for filing this Petition is enclosed herewith. Under the provisions of 37 C.F.R. § 1.181(f), this petition is timely filed within two months from the Office Action issued January 7, 2000.

I. Introduction

In the period between March 2, 1995, and June 7, 1995, Applicants filed 328 applications, including the instant application. These related applications were continuation applications of Applicants' pending application serial number 08/113,329, filed August 30, 1993.

During the period from June 1995 through November 1998, the PTO issued well over *seven hundred* Office Actions regarding these applications. Applicants diligently responded to each of these seven hundred Office Actions and, in all respects, vigorously pursued the allowance of each of these applications. These responses included over 25 thousand pages of detailed exposition of why the various grounds of rejection were improper. In this process, the assignee of these applications, Personalized Media Communications, L.L.C., expended over twenty-five man-years of attorney time. This process has cost Applicants over $500,000 in filing and other PTO fees and well in excess of $1 million in attorneys fees. Additionally, Applicants themselves expended over five man-years on prosecution activities from the Fall of 1994 to the present. Through the industrious effort of Applicants and the PTO, by November 1998, nine applications were allowed with the issue fee paid in six applications, another sixteen applications were indicated to be allowable, and some sixteen other applications included claims directed to subject matter indicated to be allowable.

In November 1998, Applicants' representatives and PTO management commenced a series of interviews. During these interviews, senior PTO management expressed the view that the further examination of Applicants' related applications could be *expedited* by reducing the number of pending applications. Applicants agreed to consolidate the claims into 56 subject matter groups as explained in detail below. Thousands of claims were cancelled from pending applications and transferred into groups of two to four applications directed to each subject

matter group. This consolidation process has cost Applicants over $500,000 in additional new claim fees under 37 C.F.R. § 1.16(b-c).

Applicants expected that the thousands of man hours of effort put forth by Applicants and their representatives in prosecuting these related application, which had resulted in hundreds of claims indicated to be allowable, would provide a solid foundation on which the further prosecution of the remaining consolidated applications would be based. To the contrary, the consolidation process has resulted in the effective suspension of the prosecution of Applicants' applications. Nearly a year passed between the consolidation of the claims in the instant application and the issuance of a complete office action. Only one other of Applicants' related applications has been addressed by the PTO since the consolidation process began over a year ago. Furthermore, during this time four of Applicants' allowed applications were withdrawn from issue after payment of the issue fee based on the contention that one or more claims therein were unpatentable. However, the PTO has provided no explanation supporting the alleged unpatentability of those claims. The prosecution of Applicants' related applications has been repeatedly delayed through the imposition of unlawful requirements on Applicants by the PTO and through the general inaction of the PTO.

A. Summary of the First Petition Request

The first request is necessitated by the repeated delay by the examiners in Technology Center 2700 in acting on this application and Applicants' related applications even as they are purportedly being directly supervised by the Director to expedite consideration of Applicants'

related applications. The present application was filed June 6, 1995, and claims priority under 35 U.S.C. § 120 of an application filed on November 3, 1981. The Manual of Patent Examining Procedure (M.P.E.P.) § 708.01(i) designates such an application as a "special case" and requires that it be taken out of turn. Each of Applicants' 328 related co-pending applications has an effective pendancy of more than five years and, thus, must be treated as "special cases" under M.P.E.P. § 708.01(i). As will be explained in detail below, this application and those related to it have not been taken out of turn and advanced for examination. Rather, their consideration has been purposefully delayed contrary to the M.P.E.P.'s mandate. The Commissioner must exercise his supervisory authority to correct this circumstance. As will be explained in detail below, the Commissioner should impose a schedule on the Examiner of this application and the other examiners handling Applicants' related applications. In Applicants' view, the delay in examination of this and all related applications is directly attributable to the PTO. Applicants have diligently sought to advance and accelerate the examination process. The present pattern of delay must be corrected.

B. Summary of the Second Petition Request

The second request in this Petition is necessitated by Examiner William Luther's improper imposition of a so-called "Administrative Requirement" included in the Office Action issued in the present application on January 7, 2000. In brief, the Administrative Requirement compels Applicants to do one of the following in order to obtain allowance of the instant application:

(1) file a terminal disclaimer in all Applicants' co-pending related applications, not just the instant application, without regard to the subject matter claimed therein;

(2) provide an affidavit attesting that no conflicts exist in any of the co-pending applications; or

(3) resolve all conflicts in all of Applicants' co-pending applications by identifying how the claims in the instant application are distinct and separate inventions from all claims in all Applicants' co-pending applications.

In essence, the Examiner seeks to require Applicants to relieve him from the obligation of examining the application for such conflicts as required by the M.P.E.P. The Examiner's stated basis for this requirement is the large number of co-pending claims. Contrary to the Examiner's assertion, as explained below, Applicants have undertaken every effort to ease any burden on the Examiner in performing his duty to compare the claims in this application with claims in the co-pending applications as required by the M.P.E.P. Applicants have consolidated claims of pending applications into groups with common subject matter. Further, Applicants have submitted extensive documentation on paper and in electronic format to assist the Examiner in analyzing and comparing the claims. Despite this, in the mere recent January 7, 2000, Office Action, the Examiner has imposed this unwarranted Administrative Requirement upon the Applicants. As the Administrative Requirement has been made a condition of allowance, Applicants' failure to comply with it will result in abandonment of the instant patent application.

The actions of the Examiner have exceeded his authority and are contrary to PTO procedures as mandated by the M.P.E.P.

II. Description of Prosecution Activities for This and Related Applications

1. The present application is a continuation application claiming the benefit under 35 U.S.C. § 120 of U.S. Patent Application, Serial No. 096,096, entitled "Signal Processing Apparatus and Methods," filed on September 11, 1987 in the name of John C. Harvey and James W. Cuddihy (Harvey 1987 application). The Harvey 1987 application is a continuation-in-part application claiming the benefit under 35 U.S.C. § 120 of U.S. Patent Application Serial No. 317,510, filed November 3, 1981, in the name of Harvey and Cuddihy and also entitled "Signal Processing Apparatus and Methods" (Harvey 1981 application). The present application claims, under 35 U.S.C. § 120, the benefit of the filing date of the Harvey 1981 application. Seven United States patents have issued to date including either the disclosure of the Harvey 1981 application or the Harvey 1987 application:

U.S. Patent No. 4,694,490
U.S. Patent No. 4,704,725
U.S. Patent No. 4,965,825
U.S. Patent No. 5,109,414
U.S. Patent No. 5,233,654
U.S. Patent No. 5,335,277
U.S. Patent No. 5,887,243

In the period between March 1995 and June 1995, Applicants filed some 328 United States patent applications which claimed the benefit under 35 U.S.C. §120 of either (i) the Harvey 1981 application through the Harvey 1987 application or (ii) solely the Harvey 1987 application. Each of these applications was a continuation application under then Rule 60, 37 C.F.R. §1.60, of U.S. Patent Application Serial No. 113,329, filed August 30, 1993, which claimed the benefit of

Harvey 1981 application through the Harvey 1987 application.[1] All Applicants' Rule 60 applications were filed prior to the June 8, 1995, effective date of those provisions of the Uruguay Round Agreements Act, Pub. L. No. 103-465, § 532, 108 Stat. 4983 (1994), which modified the effective term of issued United States patents to twenty years from the earliest effective filing date for the application under 35 U.S.C. §120. Applicants in good faith directed the claims in each Rule 60 application to what was considered distinct subject matter as will be described in greater detail below. In the period from June 1995 through November 1998, Applicants vigorously pursued allowance of each of the applications. Over twenty-five man-years of effort were exerted to prepare detailed responses in each application providing an explanation of (1) the support from the 1981 and 1987 disclosures for the claims as requested, and (2) the patentable distinctions between the pending claims in each application and the prior art. Numerous interviews were conducted. By the Fall of 1998, this effort had resulted in the allowance of nine of these applications, the indication of a notice of allowance in a further sixteen applications and the indication of allowable subject matter in an additional sixteen applications.

2. On November 25, 1998, Applicants' representatives, Donald J. Lecher and Thomas J. Scott, Jr., met with Chief Examiner Andrew I. Faile, Group Art Unit 2712, to discuss further

[1] In certain applications, the claim under 35 U.S.C. § 120 was later limited to the Harvey 1987 application.

proceedings in the PTO on Applicants' remaining unallowed applications. At that meeting, Applicants' representatives provided Examiner Faile a document entitled "Analysis of PMC Application Claims by Subject Matter Categories." [The subject category analysis document is attached as Exhibit A to this Petition.] The subject matter categories in the Exhibit A document, which had been previously identified to the PTO examiners, define the claims of the Applicants' applications based on the general subject matter to which the claims are addressed. As stated above, each PMC application had its own subject matter identification which defined the specific distinct subject matter presented in that application. For organizational purposes, Applicants grouped the applications into general subject matter categories. For example, the general subject matter category designated ADVT is addressed to systems which present advertising at receiver sites and the general category designated ASIN is addressed to systems for assembling information and instructions at a receiver site. Under these general subject matter categories, each application had a specific subject matter to which its claims were addressed.

3. At the November 25, 1998 interview, Examiner Faile indicated that the PTO desired to consolidate all Applicants' applications in each of the 56 subject matter groupings into one or two applications and then to resolve collectively any remaining issues as to the pending claims under 35 U.S.C. §112 and with regard to general double patenting issues in such consolidated applications. Examiner Faile expressed the view that the claims within each subject matter category were similar such that they could be presented in one or two applications for each category. Accordingly, Examiner Faile request the consolidation of the claims and assured

Applicants that no restriction requirements would be warranted or would be issued as a result of combining different claims into one application. Examiner Faile's stated view was that, after resolving such §112 and general double patenting issues for each group, any rejections on art or otherwise could then be resolved for that group by the responsible examiners and Applicants' representatives. Following the November interview, Applicants provided Examiner Faile by e-mail additional detailed information as to the status of all PMC's applications. Applicants' representatives had further discussions which resulted in a final interview on prosecution procedures with Examiner Faile on February 25, 1999. At that interview, a flowchart was produced to govern the "consolidation" of the various claims into a limited number of applications and their examinations by the PTO examiners. The flowchart on the consolidation process is attached to this Petition as Exhibit B. The consolidation of Applicants' groupings would, in the PTO's stated view, allow for an acceleration of the overall prosecution process.

4. Pursuant to this procedure, PMC began in Spring 1999 to consolidate its various applications, with assistance of Chief Examiner Faile, using an Interview Summary Sheet to effect the consolidation. [The general form of this Interview Summary Sheet is attached to this Petition as Exhibit C.] In each case, the surviving applications were amended to include all claims for a particular subject matter grouping and the other applications were either expressly abandoned or allowed to be abandoned by failure to respond to an outstanding PTO action. Attached to the Petition as Exhibit D is a list of the applications to remain pending for each of the 56 subject matter groupings through which the PTO was to consider all Applicants' pending

claims. In early Summer 1999, the PTO and Applicants' representatives set up a priority list for the consideration of the various groups and an interview procedure for evaluation of Applicants' applications. [These documents are attached as Exhibits E and F to the Petition.]

5. The PTO decided to assign a group of examiners under the general direction of Chief Examiner Andrew I. Faile, Art Group 2712, and Chief Examiner Tommy P. Chin, Art Group 2713, to follow the specified procedure of interviews to clarify any issues pursuant to 35 U.S.C. §112 or the relative art considerations and to generate Office Actions. During this process, numerous applications in which allowable subject matter had been noted or which had been indicated as allowable but for which issue fee documentation had not been mailed were consolidated in one or more of the 56 subject matter groupings so that the various claims could be evaluated and issued together under the PTO's new procedure.

6. The first subject matter groups to be considered by the PTO were groupings Applicants had designated with the terms (1) INTE, which covers "methods of integrating remote with local processing and imaging" and (2) MULT, which covers "coordination of multi-channel/media and multi-media presentations." Various senior PTO management, in particular, Director James L. Dwyer, promised that the PTO would issue an office action in the INTE and MULT claims in early October 1999. Copies of e-mail correspondence between Applicants' representatives and Director Dwyer regarding these office actions are attached to this petition as Exhibit G.

7. At the same time, Director Dwyer was also evaluating whether four of the five PMC applications in which the issue fee had been paid should be a part of the consolidated prosecution

procedures. (The PTO clerical staff is unable to find one of the five applications on which Applicants had paid the issue fee.) These five applications were in condition to be issued as letters patent. In fact, one had been assigned a patent number and issue date. The examination corps under the direction of Director Dwyer evaluated whether these four applications should be withdrawn from issue pursuant to 37 C.F.R. §1.313. Applicants' view was that such withdrawal was not warranted. Applicants viewed the consolidated examination process as a means to expedite prosecution. In Applicants' view, it was counterproductive to subject applications that had already been allowed to this process. A series of interviews were held with respect to the withdrawal issue on June 16, 1999; July 1, 1999, and July 13, 1999. At these interviews, the PTO examiners expressed their views as to why the claims should be not be issued. The examiners expressed the basic view that one or more claims in these applications were unpatentable either under §102, §103 or §112, i.e., not patentable over U.S. Patent No. 4,536,791 to John G. Campbell et al. or not properly supported in the original Harvey 1981 or Harvey 1987 application specifications as required by 35 U.S.C. §112. Although Director Dwyer expressed his policy that the claims should be amended to address the Examiners' concerns, no further details were given as to the specific grounds for reversing the determination that these applications were allowable. On August 5, 1999, in order to provide as much information as possible for advancing the prosecution and despite the lack of specific grounds for the determinations of unpatentability, Applicants submitted amendments under 37 C.F.R. §1.312 for certain of these applications and detailed arguments for each application as to why the various

general potential grounds for withdrawal were improper. These submissions are attached to the Petition as Exhibits H, I, J and K. On November 4, 1999, Director James L. Dwyer of Technology Center 2700 issued a letter withdrawing four of the allowed applications from issuance. No explanation for the withdrawal was provided, only a blanket statement that the applications were being withdrawn due to unpatentability of one or more of the claims. The letter indicated that the withdrawn applications would be forwarded to the examiner for prompt appropriate action. The prompt action was to include notifying applicant of the new status of the withdrawn applications. A copy of this letter is attached to this Petition as Exhibit L. No further communications regarding these applications have been received to date.

8. Attached to this Petition as Exhibit M is a chart providing the status of a representative list of Applicants' applications which had been allowed or for which allowable subject matter had previously been found.

9. In the period since June 1995, only one of Applicants' applications has been issued, Serial No. 480,060, filed June 7, 1995, issued on March 23, 1999, as U.S. Patent No. 5,887,243. (A copy of the patent is attached to this Petition as Exhibit N.) There was an error on the face page of the '243 patent as to its term. A Certificate of Correction as to this error was submitted to the PTO on April 26, 1999 and is still under consideration at the PTO. (A copy of the Certificate of Correction is attached to this Petition as Exhibit O.)

10. An Office Action was issued in the present INTE application on October 19, 1999. This Office Action was incomplete and did not include the Administrative Requirement addressed

herein. The Office Action subsequently was reissued on January 7, 2000, with supplemental rejections including the Administrative Requirement. An Office Action was eventually issued in the MULT application (S/N 08/487,526) on January 14, 2000, some three months after it was promised. The Office Action in the INTE application (as in the MULT application) includes new grounds of rejection and accordingly deems Applicants' prior response moot. To date, no other Office Action in any of the other subject matter groupings have been issued, contrary to the express promise of senior PTO management.

11. In spite of all Applicants' efforts, the Examiner has failed to deal with Applicants in good faith. He has imposed the Administrative Requirement which is totally contrary to law as explained below. Technology Center 2700, through Director Dwyer, has failed to deal with this application and the related applications with the dispatch which the M.P.E.P. mandates. This is a clear case in which the Commissioner's supervisory authority is required.

III. The Administrative Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications is Totally Contrary to Law and Should be Withdrawn.

Applicants respectfully petition the Commissioner to require the Examiner to withdraw the so called "Administrative Requirement" imposed by the Office Action mailed January 7,

2000. The unreasonable and unfair nature of the Administrative Requirement is explained in detail below.[2]

On page 128 of the Office Action, the Requirement compels Applicants to:

(1) file terminal disclaimers in each of Applicants' related applications terminally disclaiming each of the other applications;

(2) provide an affidavit attesting to the fact that all claims in all of Applicants' applications have been reviewed by Applicants and that no conflicting claims exists between the applications. Applicants would be required to provide all relevant factual information including the specific steps taken to insure that no conflicting claims exist between the applications; or

(3) resolve all conflicts between claims in the various applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the other co-pending applications.

By explicitly requiring Applicants to comply with one of these requirements to obtain allowance of the application, the Examiner has imposed a condition which will result in abandonment if Applicants fail to comply with the Requirement.

The Examiner states that the Requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. However, the

---

[2] Applicants' request through petition that the Commissioner impose an expedited schedule on the examiners responsible for this and related applications and the Director James L. Dwyer for Office Actions and other correspondence, is explained in Section IV below. A

(continued . . .)

Examiner has utterly failed to indicate which claims are conflicting. The Examiner has listed the serial numbers of Applicants' co-pending applications and attached an Appendix A that includes five claim comparisons of claims from the co-pending applications. No claim from the present application is addressed. The Examiner deems this showing to be "clear evidence" that conflicting claims exist between the 328 related co-pending applications and the present application. Further, the Examiner states that an analysis of all claims in the 329 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

As will be explained below, this requirement has no basis in law.

A. The Alleged Administrative Requirement is Outside the Scope of 37 C.F.R. § 1.78(b)

Rule 78(b) provides that:

> Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Rule 78(b) requires the elimination of conflicting claims from all but one co-pending applications. It cannot be construed to sanction the imposition of the present Administrative Requirement.

---

schedule is necessitated by the unreasonable delay created by the PTO's failure to act as detailed below.

In the January 7, 2000, Office Action, the Examiner did not establish a procedure for the elimination of conflicting claims from all but one application or provide analysis of such conflicts to effect such elimination. Instead, he has required Applicants to: 1) file terminal disclaimers in each of the related 329 applications; 2) provide an affidavit verifying that no conflicts exist; or 3) resolve all conflicts between claims in the related 329 applications. None of the options compelled by the Requirement is authorized by Rule 78(b). Therefore Applicants respectfully submit that the imposition of such a requirement is improper.

To implement the requirements of Rule 78(b), M.P.E.P. § 822.01 directs the Examiner to treat conflicting claims as follows:

> Under 37 C.F.R. § 1.78(b), the practice relative to overlapping claims in applications copending before the examiner. . . , is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of* ***provisional*** *double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. M.P.E.P. § 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

Contrary to the express directives of M.P.E.P. § 822.01 and 37 C.F.R. § 1.78(b), the Examiner here has made no effort to examine the co-pending applications nor made any rejection to achieve the elimination of conflicting claims from all but one co-pending application. He has simply ignored these mandates.

B. The Examiner's Conditioning of Further Examination and Allowance of the Applications on Compliance with the Administrative Requirement Exceeds His Authority

The Examiner has stated that failure to comply with the Administrative Requirement will result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

(1) for failure to respond within a provided time period (under Rule 135);

(2) as an express abandonment (under Rule 138); or

(3) as the result of failing to timely pay the issue fee (under Rule 316).

The PTO rules include no provision permitting abandonment for failure to comply with any of the requirements presented by the Examiner. To impose an improper requirement upon Applicants and then to hold the application as abandoned for failure to comply with the improper requirement violates the PTO rules and exceeds the Examiner's authority. Furthermore, the Examiner is, in effect, attempting to create a substantive rule which is above and beyond the rulemaking authority of the PTO, and therefore is invalid.

In the *Application of Mott*, 539 F.2d 1291, 190 U.S.P.Q. 536 (C.C.P.A. 1976), the applicant had conflicting claims in multiple applications. The C.C.P.A. held that action by the Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 U.S.P.Q. at 541. In the present application, the Examiner has asserted that there are conflicting claims in multiple applications, and by affirmatively requiring action by the Applicants, the Examiner has imposed a condition which will effectively result in an

abandonment upon failure to comply with the Administrative Requirement. Therefore, under *Mott's* analysis, the Office Action's conditional abandonment of the application is legally untenable.

C. The Allegation that Examination is Burdensome and Onerous is Obviated by Applicants' Extensive Submissions

The Examiner's justification for imposing the Administrative Requirement is that an analysis of all claims in the related co-pending applications would be an extreme burden on the PTO requiring millions of claim comparisons. The burden of comparing the claims in the pending application to the claims in 328 other applications is manageable within the context of an examination of a patent application for patentability. Such an examination includes, for instance, a determination that the claims are not obvious in view of all printed publications, including millions of issued U.S. patents, published more than a year prior to the filing date of the application. Of course, the PTO does not compare each pending claim to every printed publication, but rather relies on the expertise of the examiner and careful classification of prior patents and technical literature to focus on the prior art that is most pertinent. Applicants have diligently worked to educate the Examiner regarding the differences between the claims of the co-pending applications. Applicants have provided the PTO with Applicants' classifications of the various applications and have submitted extensive documents on paper and in electronic form to assist the Examiner in analyzing and comparing the claims at issue. See *supra.* Part II 2. Applicants and their representatives have conducted numerous interviews in an effort to answer all the Examiner's questions as to claims distinctions and similarities. In fact, after Applicants

provided the various conceptual groups used by Applicants to classify and organize the pending applications, the PTO requested that all claims in each group be consolidated into groups of two to four applications. Applicants complied with this request in an effort to eliminate any excessive burden of claim comparison on the Examiner. See *supra.* Part II 3. Applicants have submitted all information necessary to enable the Examiner to focus on the most pertinent claims for comparison under a double patenting analysis.

Despite the Applicants' efforts to work with the PTO in providing supplemental material to assist with the Examiner's task of claim comparisons, the Examiner has imposed the Administrative Requirement effectively requiring Applicants to compare the claims and make a determination for the Examiner on the double patenting issue. When an examiner is unable to articulate any reason for rejecting a patent application, 35 U.S.C. § 131 mandates issuance. By requiring a statement from Applicants regarding conflicting claims, the Examiner has ignored the material submitted by Applicants to assist the Examiner in making such claim comparisons. The Examiner may not ignore the record made by Applicants as to the relationship among the claims and simply require a blanket statement which acts as if the record were not present. The Examiner has a duty to examine that includes considering all materials Applicants have submitted.

D. The Examiner Has a Duty to Examine an Application and Can Not Shift This Duty to the Applicants

Under 35 U.S.C. § 131, the Commissioner "shall cause an examination to be made of the application . . .; and if on such examination it appears that the applicant is entitled to a patent

under the law, the Commissioner shall issue a patent therefor." The statute clearly mandates an examination to occur on behalf of the Commissioner through his agent, the examiner. The use of the mandatory word "shall" imposes a duty on the Examiner which may not be shifted to Applicants. The duty to examine is the Examiner's primary role. *See also* 35 U.S.C. §§ 101-103 (A person shall be entitled to a patent unless — . . .")

Moreover, under 35 U.S. C. § 132, "[w]henever, on examination, any claim for a patent is rejected, . . . , the Commissioner shall notify the applicant thereof, stating the reasons for such rejection . . ." This statute provides that the Commissioner must give reasons for rejecting a claim for a patent. M.P.E.P. § 706 provides that the "goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." 37 C.F.R. § 1.104 further delineates the Examiner's duty to examine and provide reasons for any and all rejections of a patent.

Here, however, the imposition of the Administrative Requirement by the Examiner shifts the burden of examination and notification of the bases for rejection to the Applicants. By forcing the Applicants to perform the task of examination, the Examiner is requiring Applicants to narrow the claims to avoid what might, by others, be considered conflicting claims. The Examiner is requiring Applicants to make an affirmative representation. When no accompanying prima facie rejection requirement has been made, Applicants have no duty to under PTO rule 56, or under any obligation found elsewhere in the rules, to determine whether claims may conflict.

This role of examination is statutorily reserved for the Examiner under 35 U.S.C. § 131. No authority exists for shifting the burden of performing the task of examination to the Applicants.

Rather than conducting a thorough examination and then articulating his basis for rejection of the instant application, the Examiner has essentially presumed obvious-type double patenting and has required Applicants to resolve the issue of obviousness-type double patenting by either: 1) filing terminal disclaimers; 2) filing an affidavit verifying that no conflicts exist; or 3) resolving all potential conflicts. Abandonment will occur if Applicants fail to comply with one of these options as required by the Examiner. Under option 1), Applicants may concede the validity of the double patenting rejection by filing terminal disclaimers and lose years of patent coverage with respect to all pending applications. Under option 2), Applicants may provide information to insure that no conflicting claims exist between the applications. Under option 3), Applicants may resolve all conflicts between the claims. All three options imposed by the Administrative Requirement are unreasonable and unfair to the Applicants and totally contrary to PTO rules and procedures. The filing of terminal disclaimers in all pending applications is essentially an admission that a double patenting rejection is appropriate when no evidentiary basis exists for that conclusion. A loss of valuable years of coverage is an unreasonable and unfair result when the Examiner has failed to establish a prima facie case of obviousness-type double patenting. Thus, if Applicants desired to traverse the double patenting rejection, under options 2) and 3), they would be, contrary to the requirements of law, forced to perform the task of examination themselves, i.e., ensure no conflicting claims exist or resolve all conflicts.

Applicants have directed the claims in each application towards specific subject matter. The claims attempt to define the specific subject matter claimed in a broad manner. Applicants are entitled to claim the subject matter invented in the broadest manner that does not encompass prior art. A narrowing of claim coverage to avoid potential conflicts is an unreasonable and unfair result when the Examiner has failed establish a prima facie case of obviousness-type double patenting

The statute and rules clearly impose on the Examiner a duty to examine an application for patent. There is no authority to shift this duty to Applicants for any reason. In the Office Action, the Examiner has cited the basis for rejection, namely obviousness-type double patenting, but has failed to provide the reasons for the rejection, which should include specific claim comparisons. Instead, the Examiner has imposed the burden of examination and determination of patentability upon Applicants. The Examiner has required Applicants to prove patentability, instead of the Examiner demonstrating reasons of unpatentability. These actions are contrary to the provisions of the Patent Act and the PTO rules and regulations.

E. Only When the Examiner Has Made A Prima Face Case May the Burden Shift to the Applicant

When rejecting claims, the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* If the Examiner fails to establish a prima facie case, the rejection is

improper and will not stand. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To support obviousness-type double patenting rejections, the Examiner must conduct the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Any resulting factual determinations are employed when making any obviousness-type double patenting analysis. M.P.E.P. §804 mandates that the analysis employed in an obviousness-type double patenting determination parallel the factual and legal analysis for a 35 U.S.C. § 103(a) rejection. Thus, when making obviousness-type double patenting rejections, the Examiner should make clear: (a) the differences between the inventions defined by the conflicting claims; and (b) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. M.P.E.P. § 804 B.1. Therefore, the M.P.E.P. procedure for determining whether conflicting claims exist in related applications makes clear that the double patenting analysis is a duty of the Examiner, which may not be forced upon the Applicant under threat of abandonment.

F. Administrative Convenience is Not a Valid Reason for Imposing the Unfair, Unreasonable Burden of Examination on the Applicants

As made clear by the U.S. Court of Appeals for the Federal Circuit, although "[*p*]*er se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103,

which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention *as claimed* in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations." *In re Ochiai*, 71 F.3d 1565, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995). "The obviousness inquiry is highly fact-specific and not susceptible to per se rules." *Litton Systems, Inc. v. Honeywell, Inc.*, 87 F.3d 1559(1), 1567(2), 39 U.S.P.Q.2d 1321, 1325 (Fed. Cir. 1996).

In the instant case, the Examiner's justification for the Administrative Requirement is the apparent burden of addressing and analyzing "millions of claim comparisons". As discussed above, the apparent burden of making claim comparisons is obviated by Applicants' extensive submissions to assist and simplify the Examiner's task of comparing claims. Further, as noted by *In re Ochiai*, administrative convenience is not a valid reason for avoiding a fact-specific analysis of claims necessitated by a proper obviousness-type double patenting rejection.

In *Transco Products Inc. v. Performance Contracting, Inc.*, 38 F.3d 551(1), 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994), *cert. denied*, 513 U.S. 1151 (1995), the district court found that the failure to disclose a stainless steel, longitudinal placement mode in the patent specification violated the best mode requirement because an applicant must update the best disclosure upon each filing of a continuing application. However, the Federal Circuit held that it would be unfair and unreasonable to impose upon applicants an additional best mode burden with each filing of a continuation application. *Id.* at 1083. Further, the Federal Circuit held that

"[a]ctions . . . taken by the PTO primarily for administrative convenience, should not increase the burden on an applicant regarding his ability to obtain patent protection." *Id.*

Contrary to the Examiner's presumption, much of the analysis involved in the examination of the first of the related applications is directly applicable to the examination of the other related applications. Due to the overlap in search areas and relevant prior art, the allegation of an undue administrative burden suggested by the Examiner is simply not justified. No court has ever implied that inconvenience to the PTO could ever be an excuse for foregoing the actual examination of a patent application required for a double patenting rejection.[3]

[3] The PTO may impose an administrative requirement on patent applicants only under clearly defined and specified circumstances. When an application claims more than one independent and distinct invention, an examiner may impose a restriction requirement pursuant to 35 U.S.C. § 121 to ease the burden of examining that subject matter, thereby requiring an applicant to file one or more divisional applications. Under M.P.E.P. § 809.02(a), the examiner may identify each of the disclosed species, to which claims are restricted. However, in some cases, such as where a large number of claims exist or the species are not easily discernible, an examiner may identify at least exemplary ones of disclosed species. In such a case, an examiner may impose the duty of grouping the claims in appropriate species on an applicant for administrative convenience. The applicant in such circumstances is assisting the examiner in a formal procedural matter. The recognized PTO procedure of requiring an applicant to divide the claims into groups in response to a restriction requirement is clearly distinguishable from the Administrative Requirement imposed upon applicants. Under the examiner's Administrative Requirement in the pending application, the examiner is requiring substantive determinations of patentability from the applicants. This task of examination is statutorily reserved for the Examiner, 35 U.S.C. § 131. No authority exists in any part of the Patent Act for its imposition upon an applicant.

G. The Chart of Apparent Conflicts in the Claims is Insufficient to Support the Administrative Requirement

To the January 7, 2000, Office Action the Examiner attaches an Appendix A which the Examiner contends to be a demonstration of claim conflicts. Appendix A fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Office Action Appendix A compares representative claims of other applications in attempt to establish that "conflicting claims exist between the 329 related co-pending applications." Absent any evidence of conflicting claims between the Applicants' present application and any other of Applicants' co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

H. The Examiner's Administrative Requirement is an Unlawfully Promulgated Substantive Rule Outside the Commissioner's Statutory Grant of Power

The Commissioner obtains his statutory rulemaking authority from Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6(a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed. Cir. 1991).[4] Applicants respectfully submit that the

[4] Accord *Hoechst Aktiengesellschaft v. Quigg*, 917 F.2d 522, 526, 16 U.S.P.Q.2d 1549, 1552 (Fed. Cir. 1990); *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 398-99, 13 U.S.P.Q.2d 1628, 1632-33 (Fed. Cir. 1990); *Ethicon Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d 1152, 1154 (Fed. Cir. 1998).

Examiner's creation of a new set of requirements, allegedly derived from 37 C.F.R. § 1.78(b), constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

In analyzing whether the requirement is outside the Commissioner's authority, one must first determine whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 U.S.P.Q.2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicants' rights and interests under the patent laws. *Fressola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the

effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

1. The PTO Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78(b)

The Examiner's Administrative Requirement is totally distinguishable from the well articulated requirement authorized by 37 C.F.R. § 1.78(b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 329 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).[5] These two well established types of double patenting use an objective standard to determine when they are appropriate[6] and have a determinable result on the allowability of the pending claims.

---

[5] M.P.E.P. § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. § 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. § 103 rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

[6] The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness

(continued . . .)

The Examiner's new Requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. The two well established double patenting standards are based on the conduct an objective analysis of comparing pending and allowed claims. However, in the present application, there are no *allowed* claims nor has the Examiner conducted any objective analysis of the claims. The Examiner's new requirement to avoid double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 328 co-pending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78(b), which states:

> Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where conflicting claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, M.P.E.P. § 804 I.B. mandates that only a *provisional*

---

requirement of patentability with the difference that the disclosure of the first patent may not be
(continued . . .)

obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new Requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 329 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims. As such, the Examiner's Requirement is a substantive rule beyond the authority of the PTO and is invalid.

2. The Administrative Requirement is also a Substantive Rule Because it Adversely Impacts the Rights and Interests of Applicants to Benefits of the Patent

The rights and benefits accorded to an owner of a U.S. patent are solely statutory rights. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that some purported new procedural rules of the PTO are actually substantive rules, e.g., when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Fressola v. Manbeck*, 36 U.S.P.Q.2d 1211, 1214 (D.D.C. 1995), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 U.S.P.Q. 145 (C.C.P.A. 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 U.S.P.Q. 143 (C.C.P.A. 1967).

---

used as prior art.

The Administrative Requirement, on its face and as applied here, is an instance of a PTO rule resulting in a substantive difference in Applicants' ability to claim their invention and, therefore, must be considered a substantive rule. The Requirement denies Applicants' rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the Requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. To require Applicants to file terminal disclaimers in each related application terminally disclaiming each of the other applications based on the PTO's incomplete examination on the merits would deny Applicants the benefit of the full patent term of 17 years on each of the Applicants' respective applications. To require Applicants to resolve all conflicts compels them to narrow their claims without the benefit of a substantive determination regarding how others may potentially interpret Applicants' claims. Indeed, to require Applicants to resolve all potential conflicts, where no conflicts have been identified, denies Applicants the benefit of the full scope of the pending claims. Applicants respectfully submit that the Requirement has a huge impact on their rights and interests in the presently claimed invention.

3. Conclusion Regarding the Administrative Requirement

In summary, the imposition of the Administrative Requirement by the Examiner improperly shifts the burden of examination to the Applicants, is outside the scope of 37 C.F.R. § 1.78(b) and is totally unreasonable under the current circumstances. The Examiner presents no basis in the pending claims for the Requirement. Further, the Requirement is a change to long

existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Since the Commissioner has no power to issue substantive rules, the Requirement is improper.

IV. The PTO's Delay in Issuing Responses is Contrary to the Guidelines Expressed in the M.P.E.P.

Applicants respectfully petition the Commissioner to invoke his supervisory authority to require the Examiner for this application and the examiners responsible for the related applications to consider this application and Applicants' related applications "special" and thus expedite the prosecution of these applications. Under M.P.E.P. § 708.01, applications pending more than 5 years, including those relating to a prior United States application, qualify as "special cases" and provides that such applications are advanced out of turn for examination. Accordingly, under M.P.E.P. § 707.02(a), the supervisory primary examiners responsible for these applications should make every effort to assure that the PTO takes prompt action to finally dispose of such applications, including monitoring the pendency of the application, locating the best references and carefully applying them, and generally expediting prosecution. In effect, every effort should be made to terminate the prosecution of a case having a pendency of more than 5 years.

The instant application was filed June 6, 1995, over four years ago, and has an effective pendency of more than five years and, therefore, qualifies as a "special case." In fact, this application has an effective pendency of more than 18 years, far more than the 5 years of pendency required for a case to be deemed "special," *see supra* Part II 1, and, therefore, is

entitled to expedited examination. In accordance with the M.P.E.P., the Examiner should act upon this application and the related applications without delay.

The record in this application, as demonstrated above, includes no indication that anyone exercising authority at the PTO has ever considered the present application or any related application to be "special" and treated it accordingly. To the contrary, before and after the issuance of U.S. Patent No. 5,887,243 in March, 1999, the PTO examiners responsible for these applications have purposefully delayed all actions regarding this application and Applicants' co-pending applications. In March 1999, another five of Applicants' related applications had been allowed and the issue fees had been paid. The senior PTO management overseeing the examination of Applicants' applications expressed the view that some unspecified claims in the allowed applications claims may be unpatentable over particular references or may be unsupported by the disclosure. At the June 16, 1999, interview, Director Dwyer indicated that these allowed applications should be issued if amendments were made to address the examiners concerns. However, in that interview the PTO provided no specific grounds for believing that any claim in these applications was unpatentable. Notwithstanding the absence of any substantive rejection, Applicants provided responses detailing the differences between the claims and the references mentioned by the examiners and detailing how the specifications support the claims. The response from Director Dwyer, was a letter withdrawing four of the five cases from issue. See *supra.* Part II 7. When withdrawing the applications from issue, Director Dwyer provided no specific reasons to support the alleged unpatentability of any of the withdrawn

claims. No action has been taken in the fifth case because it is allegedly misplaced at the PTO. Applicants submit that subjecting applications that have been allowed to further examination fails to constitute an effort to terminate prosecution and is thus totally contrary to the policy expressed in M.P.E.P. § 707.02(a). The effect of the withdrawal from issue is thus a further examination of four allowed applications in an attempt to justify the withdrawal itself. Applicants find this delay inexcusable and submit that it is contrary to the PTO's own rules regarding withdrawal of applications from issue and the handling of "special" cases.

Also, at the time of the issuance of the Patent No. 5,887,243, Applicants and the senior management overseeing Applicants' applications had agreed on the consolidation procedure to expedite the prosecution of the remaining unallowed applications. See *supra.* Part II 3. Under this procedure, Applicants expected that the PTO would act on each consolidated subject matter group after slightly over a month of consideration. However, over seven months passed between the consolidation of claims into the present application and any action by the PTO. The PTO issued an incomplete Office Action on October 19, 1999. In a November 1999, interview, attended by the Group Director, Applicants brought these deficiencies to the PTO's attention. See *supra.* Part II 6. As a result, the Office Action issued on October 19, 1999, was reissued nearly three months later on January 7, 2000. The reissued Office Action included supplemental rejections including the Administrative Requirement discussed above, which were not included in the original Office Action issued in October. See *supra.* Part II 10. Therefore, over ten months passed between the consolidation of the claims in the present application and the issuance of the

resulting Office Action. The only other Office Action issued in any related application was issued in the MULT application on January 14, 2000. The MULT Office Action had also been promised in early October, 1999. The PTO specifically promised that further office actions in related cases would issue shortly after the issuance of the action in the MULT application. To date, no further communication has been received in any of the related applications.

The consolidation process has failed to expedite the prosecution of these related applications. To the contrary, it has actually resulted in the effective suspension of the prosecution of the related applications while each subject matter grouping is considered in turn at a totally undisciplined pace. At the current rate of action by the PTO, the examination process for these applications will take many years. The outstanding Office Action in the present application was in response to Applicants' amendment to the claims. The amendment included new claims corresponding to claims cancelled from two co-pending applications directed to INTE subject matter. The claims were amended to enhance their clarity as discussed with the Examiners through the interview process. Specific specification support from the specification was provided for certain claims. Distinctions between pending claims and certain claims from Applicants' issued patents were enumerated upon the suggestion of the Examiners. Applicants' amendment made no substantive change to the scope of the claims. The amendment was primarily intended to consolidate claims and more clearly the define the INTE subject matter. Yet nearly a year passed before the PTO issued a complete office action in response to the amendment. This delay occurred despite the advancement of the prosecution of the instant

application through two prior substantive office actions in the instant application and similar prior consideration of the added claims transferred from the two now abandoned INTE applications. Applicants' claims have been repeatedly considered by the PTO. Numerous interviews have been conducted where the details of Applicants' claimed inventions have been explained. Further, Applicants have consolidated the pending claims into a limited number of applications at the request of the PTO. There is no practical impediment to the expeditious consideration of Applicants' remaining applications. The present procedure followed regarding the prosecution of these related applications is contrary to the mandate of M.P.E.P. § 707.02(a), which requires every effort be made to terminate the prosecution of these applications.

Applicants believe that the consolidation process can be conducted within the time limits which the PTO examiners proposed themselves in Exhibit F. This process will result in substantive actions regarding each subject matter group to be issued after a little over a month of concentrated consideration by the examiner assigned to each case. The process allows for input from Applicants to provide all information required for the Examiner to issue a prompt substantive action. Applicants note that some forty applications included claims that are presently under consideration by the PTO and are directed to subject matter which has been indicated to be allowable. See *supra.* Part II 5. Applicants submit that the consolidation process as originally conceived will result in the expeditious presentation of claims directed to allowable subject matter that may be promptly issued. The PTO should consider each consolidated subject matter group without delay. Applicants submit that a schedule including time limits to act on

each subject matter group must be adhered to in order to ensure that the consolidation process, which was agreed upon between Applicants and senior PTO management, meets the mandate of § 707.02(a) of the M.P.E.P.

Applicants specifically request supervisory authority over the actions of Director Dwyer. After repeated attempts by Applicants to encourage and facilitate prompt action on the applications by the examiners supervised by Director Dwyer, no improvement in the examination process is discernable. Director Dwyer's actions, in fact, have led to unreasonable delays in the prosecution of this application and related applications. For example, Director Dwyer had specifically promised Applicants that the PTO would issue an office action on the INTE and MULT claims in early October 1999. While the Examiner did issue an office action in the INTE application on October 19, 1999, that office action was deficient and had to be reissued with a supplemental rejection on January 7, 2000. The revised office action was so different in scope that it effectively required an entirely new response from Applicants. After numerous correspondence and inquiries, an office action in the MULT application was eventually received on January 14, 2000, more than three months after this issuance had been promised by Director Dwyer. See *supra.* Part II 10. On another occasion, after issuing notices of allowances on five related applications and after Applicants had paid the issue fee on all five applications, Director Dwyer authorized a withdrawal from issue of four of the applications. See *supra.* Part II 7. No action has been taken on the fifth as it is allegedly misplaced by the PTO. No explanation has been given for these severe actions nor has further action notifying applicants of the new status of

these applications issued as was promised in the notice of Withdrawal From Issue. Applicants' efforts to ease the burden of examining the many related co-pending applications have not been received by the examiners of Technology Center 2700 with a view to finally concluding the prosecution of these applications. Rather, Applicants' efforts have been used by Director Dwyer and the examiners of Technology Center 2700 under his supervision to delay prosecution while the examiners interminably ponder the merits of Applicants' applications.

Due to the lack of relief from Director Dwyer on numerous issues, Applicants request supervisory authority over Director Dwyer himself. In addition, due to the unreasonable delay on repeated occasions, Applicants request that an expedited schedule be imposed on Director Dwyer and the examiners under his supervision responsible for this application and other related applications to ensure that all these application are considered with the dispatch accorded to "special" applications. Such a schedule should impose a time limit prohibiting further delay in issuing Office Actions and other correspondence in this application and Applicants' related applications

V. Petition for Withdrawal of Requirement and Imposition of a Schedule

In conclusion, Applicants submit that the Examiner has exceeded the scope of his authority in improperly imposing requirements on the Applicants which are contrary to the Patent Act, and the PTO's rules and regulations. Applicants respectfully request that the Commissioner require the Examiner to withdraw the Requirement that Applicants: (1) file terminal disclaimers in each of the related 329 applications terminally disclaiming each of the other co-pending

applications; (2) provide an affidavit attesting to the fact that all claims in the co-pending applications have been reviewed by Applicants and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the co-pending applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 329 applications, which upon failing to do so will abandon the application.

Under 37 C.F.R. § 1.105, § 1.106 and § 1.78(b), the Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

Further, Applicants respectfully request that the Commissioner impose a schedule on the examiners supervised by Director Dwyer expediting the examination of this application and related applications. Although Applicants have provided comprehensive submissions to assist the examiners in comparing and analyzing the claims, the examiners have continued to neglect the examination of these applications resulting in compounded delays. Thus, Applicants respectfully request that a schedule be imposed on Director Dwyer requiring compliance with the PTO's commitment to proper disposition of applications that have been pending for more than 5 years.

The PTO has delayed the examination of this and the related applications for far too long. Further delay is unconscionable. The Commissioner should impose a schedule on Technology Center 2700 requiring prompt examination and disposition of these applications. Applicants suggest that the Commissoner require that all consolidated groupings have an initial Office Action within thirty days of the grant of this Petition and that a further Office Action be issued within thirty days of the receipt of any Response or Amendment to such initial Office Action.

Respectfully submitted,

HUNTON & WILLIAMS

By: Thomas J. Scott

Thomas J. Scott, Jr.
Reg. No. 27, 836

HUNTON & WILLIAMS
1900 K Street, N.W.
Washington, D.C. 20006-1109
Telephone: (202) 955-1500
Facsimile: (202) 778-2201
February 28, 2000